

Inventor : Shalaby et al.
Serial No. : 09/762,431
Filed : May 22, 2001
Page : 3

Remarks

Reconsideration of the instant Office Action, entry of the amendments submitted herewith, withdrawal of the rejection of the claims 1, 11 and 19 and of the objection to claim 12, in view of the amendments and remarks presented herein, and allowance of claims 11, 12 and 19 are respectfully requested.

In the instant Office Action, claims 1-28 are listed as pending, claims 2-10, 13-18 and 20-28 are listed as withdrawn from consideration, claims 1, 11 and 19 are listed as rejected and claim 12 is objected to as being dependent upon a rejected base claim.

Claims 11 and 19 are amended and claims 1-10, 13-18 and 20-28 are canceled.

Claims 2-10, 13-18 and 20-28 are canceled solely in response to the restriction requirement and without prejudice to their presentation in an appropriately filed divisional application.

**The Objection to the Information
Disclosure Statement Filed January 24, 2002**

The examiner has not considered the Information Disclosure Statement filed January 24, 2002, in its entirety, due to Applicants' failure to fully comply with 37 C.F.R. §1.98(a)(2). In particular, the Examiner states that Applicants failed to provide a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Applicants are grateful to the Examiner for considering those publications that Examiner was able to obtain, despite the deficiencies of said statement. Applicants submit herewith a 2nd

Inventor : Shalaby et al.
Serial No. : 09/762,431
Filed : May 22, 2001
Page : 4

Supplemental Information Disclosure Statement directed to the references that the Examiner indicated were not considered. Applicants respectfully submit that said 2nd Supplemental Information Disclosure Statement complies fully with 37 C.F.R. § 1.98(a)(2) and requests the Examiner's consideration of the references cited in the accompanying Form PTO-1449.

The 35 U.S.C. §112, Second Paragraph, Rejection

The Examiner rejected claim 19 under 35 U.S.C. §112, Second Paragraph, for "failing to particularly point out and distinctly claim the subject matter to which applicant regards as the invention" due to the lack of antecedent basis for the claimed polymer. Claim 19 has been amended to replace the phrase "an absorbable polymer according to claim 1" with the phrase "an absorbable polyester according to claim 1." Applicants submit that claim 1 provides sufficient antecedent basis since it is directed to an absorbable polyester. No new matter is introduced by this amendment since Example 12 found at page 13, line 24-31, discusses use of an absorbable polyester as an acidic excipient of a cyanoacrylate composition. As such, claim 19, as amended, is clearly supported by the specification.

Accordingly, the rejection of claim 19 under 35 U.S.C. §112, Second Paragraph, is obviated. Applicants respectfully request that said rejection be withdrawn.

The 35 U.S.C. §103(a) Rejection

Claims 1, 11 and 19 stand rejected as being anticipated by Shogren, R. L., *Complexes of Starch with Telechelic Poly(ε-Caprolactone) Phosphate*, Carbohydrate Polymers, 22:93-8 (1993) (hereinafter "Shogren"). It is alleged that Shogren teaches phosphorylated poly(ε-caprolactones) which are "identical chemical structure[s]" to the novel

Inventor : Shalaby et al.
Serial No. : 09/762,431
Filed : May 22, 2001
Page : 5

phosphorylated polymers of the instant application. Without conceding the correctness of the Examiner's rejection and solely to place the present application in better condition for allowance, the Applicants have canceled claim 1 and amended claim 11 to delete " ϵ -caprolactone" from the Markush group consisting of possible monomers that can comprise the polyester chain. In addition, claims 12 and 19 have been amended to be dependent on claim 11.

The Court of Appeals for the Federal Circuit, in ruling on the standard for anticipation under 35 U.S.C. §102(b), stated:

[i]t is elementary that an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice or device.

See *In re Donohue*, 226 U.S.P.Q. 619, 621 (1985); and further stated:

...exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference.

See *Atlas Power Co. v. E. I. duPont DeNemours & Co.*, 224 U.S.P.Q. 409, 411 (1984).

Applicants respectfully contend that Shogren does not disclose absorbable polyesters having at least one monophosphate functionality wherein the polyester is comprised of monomer units of L-lactic acid, D-lactic acid, DL-lactic acid, malic acid, citric acid, tartaric acid, ϵ -caproic acid, alkylene oxalate, cycloalkylene oxalate, alkylene succinate, β -hydroxybutyrate, glycolide, glycolic acid, L-lactide, D-lactide, DL-lactide, meso-lactide, trimethylene carbonate, p -dioxanone, 1,5-dioxepan-2-one or 1,4-dioxepan-2-one. Applicants further contend that U.S.

Inventor : Shalaby et al.
Serial No. : 09/762,431
Filed : May 22, 2001
Page : 6

Patent 5,635,216 (hereinafter "the '216 patent") does not teach the inherent benefits of including a monophosphate functionality on biodegradable and/or bioerodible polyesters. Thus, neither Shogren nor the '216 patent teach each and every element of amended claims 11, 12 and 19 and neither Shogren nor the '216 patent, therefore, are anticipatory of amended claims 11, 12 and 19.

In light of the foregoing, Applicants respectfully request the withdrawal of the rejection of claims 11, 12 and 19 and further request the allowance of the amended claims.

Applicants are grateful for the Examiner's allowance of claim 12 conditioned upon rewriting said claim in independent form including all of the limitations of the base claim. Applicants contend, however, that based on the above-amendments, claim 12 need not be rewritten in independent form as suggested by the Examiner and is in a condition for allowance.

Conclusion

Based on the above remarks, Applicants submit that all of the rejections and objections have been overcome and that all pending claims are now in a condition for allowance, which action is respectfully requested. Should Examiner Berman deem that any further action by the Applicants would put this application in order for acceptance, she is requested to contact the Applicants' undersigned representative.

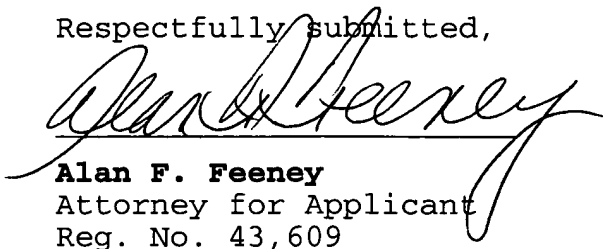
Inventor : Shalaby et al.
Serial No. : 09/762,431
Filed : May 22, 2001
Page : 7

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0590.

Date: 5-20-2003

Biomeasure Inc.
27 Maple Street
Milford, MA 01757-3650
(508) 478-0144

Respectfully submitted,


Alan F. Feeney
Attorney for Applicant
Reg. No. 43,609